

REMARKS

Claims 5-10 are all the claims pending in the application. Claim 5 has been amended to further define the dispersible compound, and support for the amendment can be found, for example, page 5, lines 9-13 of the present specification.

Entry of the above amendment is respectfully requested.

I. Response to Rejection of Claims 5-10 under 35 U.S.C. §112, first paragraph

At pages 2-3 of the Office Action, claims 5-10 are rejected under 35 U.S.C. §112, first paragraph.

The Examiner asserts that the specification is enabling for the dispersible compound being a compound that includes oligomers, however, the specification is not enabling for other compounds, such as gaseous compounds, liquid compounds, etc.

Applicants respectfully traverse the rejection.

The test for enablement is whether the disclosure in the specification is sufficient to enable one of ordinary skill in the art to practice the claimed invention without undue experimentation. The fact that experimentation is necessary is not conclusive of non-enablement but any necessary experiment should not be undue. Further, a specification may be enabling without any working examples. *See* MPEP 2164.02.

The dispersible compound dispersible in the polyamic acid resin of the present invention is described at page 12, line 24 to page 14, line 10 of the present specification. In addition,

preferable dispersible compounds are a polyacrylate oligomer, a polyether oligomer, a polyester oligomer or a polyurethane oligomer. *See* page 5, lines 9-13 of the present specification.

Further, in this case, the specification contains seven (7) Examples and five (5) Comparative Examples, thereby providing ample guidance for one skilled in the relevant art to make and/or use the claimed invention.

The Examiner asserts that the specification is not enabling with respect to dispersible compounds, such as gaseous or liquid compounds. However, given the disclosure, it is respectfully submitted that the specification does enable one skilled in the art to make and or use the invention, without undue experimentation. Accordingly, the specification does satisfy the enablement requirements of 35 U.S.C. § 112, first paragraph.

However, to advance prosecution, claim 5 has been amended to further define the dispersible compound for further clarity based on page 5, lines 9-13 of the present specification.

In view of the above, withdrawal of the rejection is respectfully requested.

II. Conclusion

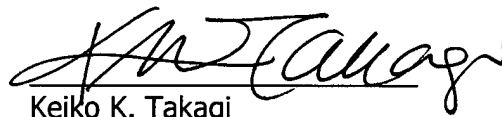
For the above reasons, reconsideration and allowance of claims 5-10 is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 10/736,529

Attorney Docket No.: Q78606

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

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